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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/865,750 | 05/25/2001 | Yuichi Shirota | 4041J-000385 | 4254 |
| 27572 | 7590 | 03/09/2004 | EXAMINER | |
| HARNES, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303 | | | CIRIC, LJILJANA V | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3753 | |

DATE MAILED: 03/09/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,750

Applicant(s)

SHIROTA ET AL.

Examiner

Ljiljana (Lil) V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6-13,15,17,18,21-28 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,14,16,19,20 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 9, 2003 has been entered.

2. Claims 1 through 30 remain in the application, all as amended either directly or indirectly. Claims 2, 3, 6 through 13, 15, 17, 18, 21 through 28, and 30 remain withdrawn from consideration as being drawn to the non-elected species/inventions.

Response to Arguments

3. Applicant's amendments to the claims have generally obviated the specific rejections of at least the broad independent claims under 35 U.S.C. 112, first and second paragraphs as cited in the previous Office action; nevertheless, the amendments give rise to other issues as noted in greater detail later in the instant Office action. Thus, applicant's arguments with respect to the claims as rejected in the previous Office action have been considered but are moot in view of the new grounds of rejection presented herein.

Nevertheless, the examiner wishes to respectfully remind the Applicant that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Election/Restrictions

4. Claims 2, 3, 6 through 13, 15, 17, 18, 21 through 28, and 30 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. Note that proper amendment practice now requires that withdrawn claims be identified as such in the claims listing. The dependent withdrawn claims will be rejoined as appropriate upon allowance of the independent claims from which they depend.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there appears to be no proper antecedent basis for the "*self-contained* cold accumulator" as now recited in the claims.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4, 5, 14, 16, 19, 20, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have been amended to recite "a *self-contained* cold accumulator," yet there is no proper antecedent basis in the originally filed disclosure for this term as a whole, nor has the term "self-

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contained” been adequately defined for the record via applicant’s arguments so as to clearly define what is included and what is excluded thereby. Please note that cold accumulator 40 as shown in Figure 1 of the instant invention, for example, is not entirely self-contained in that the cold accumulator 40 relies for operability on air flowing therethrough AND through the duct or case in which the accumulator is disposed. Thus, as used to qualify the cold accumulator, the term “self-contained” is of undeterminate scope and thus renders the claims indefinite with regard to the scope of protection sought by the claims.

Claims 5, 14, 20, and 29 are still generally narrative and indefinite, still failing to conform with current U.S. practice. For example, it is not clear which particular structures if any are necessarily encompassed by the limitations beginning with “in such a manner that...” and going to the end of each of claims 5 and 14. Each of claims 14 and 29, on the other hand, comprise a series of run-on limitations, some lacking proper antecedent basis (i.e., “the refrigerant cycle”), the exact scope of which thus cannot readily be determined.

Furthermore, each of dependent claims 4, 5, 14, 19, 20, and 29 recites a “wherein clause” which renders the intended scope of protection sought indefinite since generally, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive. If applicant intends to positively recite the elements recited as part of these “wherein” clauses, applicant should amend the claims to clearly do so, such as by replacing “wherein” with “further comprising” or similar, as appropriate.

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The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. As best can be understood in view of the indefiniteness of the claims, claims 1, 4, 5, 14, 16, 19, 20, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 1-153321 (previously of record).

JP 1-153321 (as admitted by applicant on page 3 of the application as originally filed) discloses a vehicular air conditioner essentially as claimed, including, for example: a cold accumulator 68 disposed in the air conditioner case or duct as shown in the figure of the reference; a cooling heat exchanger or evaporator 40, the evaporator 40 being part of the associated refrigerant cycle as shown in the figure of the reference; an air mixing door or heating adjustment member 60; and, a heating heat exchanger 28 disposed at a downstream side of the cooling heat exchanger or evaporator 40. As broadly interpreted as required, the cold accumulating material or refrigerant is inherently and necessarily sealed within the cold accumulator 40 (and associated piping) such that it does not contaminate the passenger compartment of the vehicle or the environment. Also as broadly interpreted as required, cold accumulator 40 is “self-contained” to the extent that the cold accumulator is contained within its own casing or housing and constitutes a separate element 68 of the system as shown in the figure of reference. Little or no patentable

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weight is being given to the optional limitations recited as part of the "wherein" clauses in each of the dependent claims 4, 5, 14, 19, 20, and 29.

The reference thus reads on the claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

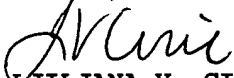
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

March 5, 2004



LJILJANA V. CIRIC
PRIMARY EXAMINER
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